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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,453	08/16/2001	Akihiro Ouchi	862.C2332	1321

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EXAMINER	
HOLTON, STEVEN E	

ART UNIT	PAPER NUMBER
2673	

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/930,453	OUCHI ET AL.	
	Examiner	Art Unit	
	Steven E. Holton	2673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 August 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *16 August 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *10/2001*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claim Objections

1. Claim 10 is objected to because of the following informalities: the incorrect use of the homonym 'brake' instead of 'break' and for the difficult to understand phrasing of the claim. The claim states, "wherein said data, to which page brake or index information is added, is stored." This can be read to mean that either 1) the user is able to use symbols or input cues to indicate formatting such as index numbers of page breaks in the handwritten image data that is stored, or 2) the system has some way of adding page break or index information to the data as it is stored on the device. Upon reading the specification the examiner assumes the first meaning as listed, that the user is able to add page break or index formatting to the data through specific actions or buttons. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-9, 11, 14, and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneko et al. (USPN: 4931965), hereinafter Kaneko, in view of Wildes et al. (USPN: 5212645), hereinafter Wildes.

Regarding claims 1 and 16, the examiner notes that claim 16 is merely a method of using the device disclosed by claim 1; therefore, by showing prior art

would lead to produce a device of claim 1, it follows that said device would be operated using the method disclosed by claim 16. Kaneko discloses, "An electronic board apparatus (Fig. 1) for transmitting data representing a handwritten image written on a predetermined board (Fig. 1, element 8) to an external computer (col. 4, lines 15-18), comprising:

Storage means for storing said data (Fig. 1, in element 1, labeled 'RAM')." However, Kaneko does not expressly disclose, "means for determining whether or not said external computer can receive said data; and... wherein if it is determined that said external computer cannot receive said data, said data is stored into said storage means." Wildes discloses a networked tool management system where data about the status of remote locations is sent back to a central computer system for analysis and storage. In the system, data is first placed into a temporary storage before being sent to the main control programs (col. 7, lines 4-13, the 'raw data ring buffer'). Wildes also discloses, "if the connection to a data or event server is severed, no interruption in the rest of the system must be seen...tasks redirect their output to a null device then periodically try to reestablish the connection to their respective server (col. 10, lines 25-30)."

Kaneko and Wildes are related in the desire to transmit data from a device to another computer system for further processing or display of the data. The data and event servers disclosed by Wildes are external systems to the remote tools where data is generated. Wildes shows that there would be motivation to provide the ability to store information in temporary memory because "without this capability, the first part of the next piece of data dumped to the server will be

lost (col. 10, lines 34-36)." Similarly, at the time of invention one skilled in the art would be motivated to use a test of the data transmission connection to assure that handwriting data made on the input board would not be lost due errors or outages of the network and store the information within the RAM on the device as disclosed by Kaneko until the network connection was confirmed. Thus, it would have been obvious to one skilled in the art to combine a system of testing a connection link and either temporarily storing or sending data to an external computer system as disclosed by Wildes with a writing board system as disclosed by Kaneko to produce a writing board able to store information if a network connection was non-functioning to produce the device disclosed in claim 1 and operated using the method of claim 16.

Regarding claim 2, Wildes discloses a system where the data is sent to the central server in real-time, but if the connection is lost the data is stored until a connection is reestablished (col. 9, line 33 to col. 10, line 36). Such as system chooses to transmit the data to the external computer when it determined that the connection is valid, and only stores data for more than a moment when a connection is found to be invalid.

Regarding claim 3, Wildes discloses a system where when a data connection is lost information is not sent from the input devices until a connection is reestablished (col. 10, lines 25-36). Wildes appears to assume that there will always be data saved during the time a connection is reestablished, but the system would inherently have some way of determining where data information was stored in memory so that when a connection was reestablished only data

would be sent. Thus, there would be a system in place that would determine that data was stored within the memory from the time the connection was judged to be invalid to the time the connection was judged to be valid again.

Regarding claim 4, Kaneko does not expressly disclose what would be part of the coordinate information used by the input device, but the device uses a pen for input purposes and does not specify exact locations on the input device where the user could not properly input. Therefore, it would be very possible for a user of the system to input images that would include characters, letters, figures, tables or any other data that can be made using a pencil and paper. These types of images cover the limitations of claim 4.

Regarding claim 5, Kaneko discloses an input apparatus that is regarded as "a coordinates input apparatus (abstract, line 1). The device represents all input data as coordinate information. Such information would represent any handwritten images that are input on the device, and teach the limitations of claim 5.

Regarding claims 6 and 17, the examiner notes that the method of claim 17 is a method of using a device as claimed in claim 6. Kaneko discloses, "further comprising display means (fig. 1, element 11) for displaying said handwritten image based on said data." The examiner notes that a device using the limitations of claim 6 could then be operated using the method disclosed by claim 17.

Regarding claim 7, Kaneko does not expressly disclose that the display means could display an image based on the data stored in the storage means,

however, the display can receive coordinate information directly from the processor of the device, it would be just as able to send coordinate information from a stored location in the memory of the device. This would produce a device as specified in claim 7.

Regarding claim 8, Kaneko discloses, "...wherein a display device to display said handwritten image based on said data is connectable to said apparatus (col. 4, lines 5-8)." Kaneko discusses that the device can send the coordinate information to an external computer or other device. A computer can be used as a display device and the connection could also be made to send data directly to a monitor or other visual display device.

Regarding claim 9, Wildes discloses, "further comprising data transfer control means for controlling timing of transmission of data to said external computer (col. 10, lines 27 and 28, the "data dump and network log tasks')." The examiner notes that the tasks discussed by Wildes are means that control when data is sent over the network connection and monitor the network connection to make sure that it is valid and functioning properly.

Regarding claim 11, the examiner takes Official Notice that is old and well-known in the art to allow for removable memory cards such as computer disks and other similar devices for storage of information for a portable device. Therefore, it would have been obvious at the time of invention for one skilled in the art to allow the memory device used to store coordinate information to be removable from the input device. This would allow the user to expand the

amount of memory available and allow for transport from the device to a base station for later reproduction or retrieval.

Regarding claim 14, the examiner notes that the limitations of this independent claim are a combination of the limitations and preamble of claim 1. Because of the similarities of the limitations of the two claims, the arguments used to reject claim 1 are used to reject claim 14.

3. Claims 10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneko in view of Schmidt as applied to claims 1 and 14 above, and further in view of Bricklin et al. (USPN: 5539427), hereinafter Bricklin.

Regarding claim 10, as shown above, the combination of Kaneko and Schmidt disclose all of the limitations of claim 1 that are part of claim 10; however, they do not expressly disclose, "wherein said data, to which page brake or index information is added, is stored." Bricklin discloses a graphic indexing system used to store graphic information for recall at a later time. The system allows the user to select a portion of the input graphic data to be index information, and then stores associated text with the index information.

Bricklin is analogous art because he deals with text and handwritten input on an electronic pad device. At the tine of the invention it would have been obvious to one skilled in the art to use an indexing system similar to the system defined by Bricklin to store multiple entries on a board input apparatus constructed from the combination of Kaneko and Schmidt. The motivation for doing so would have been to allow for more than one page of information to be

input using the handwriting device, and that the information could be retrieved for re-display. Therefore, it would have been obvious to use a graphic indexing system combined with and handwriting input device to produce an input apparatus as specified in claim 10.

Regarding claim 15, as shown above, the combination of Kaneko and Schmidt disclose all of the limitations of claim 14 that are part of claim 15. Kaneko also discloses, "display means for displaying said handwritten image based on said data (Fig. 1, element 11)." However, neither Kaneko nor Schmidt expressly disclose, "selection means for selecting one of a first mode and a second mode,

Wherein said first mode, said display means displays said handwritten image based on said data from said data generation means,

And wherein said second mode, said display means displays said handwritten image based on said data stored in said storage means."

Bricklin discloses a system for indexing and retrieval of graphically input data. There is no specifically mention a selection means for picking one mode or another, such a means must exist within the system because a user is able to both enter new data and retrieve old data. When entering new data, the coordinates of the inputted information will be shown as quickly as inputted because the user can "select a portion of the text for indexing without disrupting the natural handwriting action (abstract, lines 10-12)." If the images were not displayed from the recently input data, the flow of handwriting would be interrupted. Thus this input style is the same as the claimed 'first mode' of

operation. When the user reviews the indexed information in the system, stored information can be shown and this corresponds to the claimed 'second mode' of operation. Thus, the combination of an indexing and review method as disclosed by Bricklin with a handwriting input device as disclosed by the combination of Kaneko and Schmidt would produce a device as specified in claim 15

4. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneko in view of Schmidt as applied to claim 1 above, and further in view of Davis et al. (USPN: 6232962), hereinafter Davis.

Regarding claims 12 and 13, as shown above, the combination of Kaneko and Schmidt disclose all of the limitations of claim 1 that are part of claims 12 and 13. Davis discloses a detector assembly (Fig. 7D, element 72) that can be "attached along the top, bottom, or side of the writing surface (col. 42, lines 3-4)." This device therefore can be 'provided at one end of the board' as part of claim 12 and could be 'removable from said board' as part of claim 13.

Davis is analogous art because he deals with a board input apparatus for use as a handwriting input system. At the time of invention it would have been obvious to one skilled in the art to enclose a sensor device as disclosed in the combination of Kaneko and Schmidt in a movable and detachable housing as taught by Davis. The motivation for doing so would have been to provide a device that was portable and able to be positioned as needed for a specific input or display function, such as moving from one room to another during the middle of a presentation. The device could be taken down and moved to another area

and the presentation restarted without any data lost or extra setup of a new system required. Thus, it would have been obvious to embody a handwriting board input apparatus in a portable housing to produce a device as disclosed in claims 12 and 13.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven E. Holton whose telephone number is (571) 272-7903. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on (571) 272-7681. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S.E.H.
March 2, 2005

Steven E. Holton
Examiner
Art Unit 2673

JIMMY NGUYEN
PRIMARY EXAMINER